UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,187	06/12/2001	Toshio Morita	Q61610	1960

7590 12/30/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER	
LISH, PETER J	

ART UNIT	PAPER NUMBER
1754	

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/878,187	MORITA ET AL.	
	Examin r	Art Unit	
	Peter J Lish	1754	

-- The MAILING DATE of this communication appears on the cov r sh t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-5 *13,15 and 16* is/are pending in the application.

4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13 and 15-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's arguments, with respect to the rejection of claims 13-15 over prior art to Tamura et al. and to Hiraoka et al. have been fully considered and are persuasive. The rejections of claims 13-15 as unpatentable over these references has been withdrawn.

Applicant's arguments with respect to the rejection of claims 13-15 over prior art to Kyotani et al., Tennent et al., and Harada et al. have been fully considered but they are not persuasive.

Regarding the rejection over Kyotani et al., applicant argues that Kyotani does not explicitly teach the degree of crystallinity of the fibers, assumedly arguing that the fibers of Kyotani et al. are not graphitized. However, it is expected that the fibers of Kyotani et al. be graphitized due to the heat treatment at 2800 °C, a process that is known to graphitize carbon. Applicants additionally argue that the process of producing the fibers of Kyotani does not use a catalyst material, however, it is held that the method of production does not limit the material itself. No difference is seen between the carbon fibers of Kyotani et al. and those of the instantly claimed invention. Where, as here, the claimed and prior art products are identical or substantially identical, the burden of proof is shifted to the applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See In re Best, 195 USPQ 430.

Regarding the rejection over Tennent et al., the vapor-grown carbon fibers discussed in column 2 are those used in the rejection. Where, as here, the claimed and prior art products are identical or substantially identical, the burden of proof is shifted to the applicant to prove that the

prior art products do not necessarily or inherently possess the characteristics of his claimed product. See In re Best, 195 USPQ 430.

Regarding the rejections over Harada et al., applicant argues that the comparative example in the specification of the instant application proves that high-temperature heat treatment performed other than by the method of example 1 results in a metal content of greater than 100 ppm. First, this is assuming the same initial concentration of metal. Second, the comparative example also recites the destruction of the furnace in which the high-temperature heating takes place. It is expected that this does not occur in the process of Harada et al., as no mention is made to it. Therefore, the comparative example cannot be relied upon to determine the amount of metal impurity in the carbon fibers of Harada et al. No difference is seen between the carbon fibers of Harada et al. and those of the instantly claimed invention. Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to the applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See In re Best, 195 USPQ 430.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102/103

Claims 13 and 15-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kyotani et al. ("Preparation of Ultrafine Carbon Tubes...").

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Claims 13 and 15-16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tennent et al. (USPN 6,235,674).

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Claims 13 and 15-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harada et al. (USPN 5,409,775).

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Lish whose telephone number is 571-272-1354. The examiner can normally be reached on 9:00-6:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PL

STUART L. HENDRICKSON
PRIMARY EXAMINER